REMARKS

Claims 1-25 and 28-30 are pending in this application. Claims 26 and 27 have been cancelled. In an office action dated December 31, 2003, the Examiner rejected Claims 1-25 and 28-30. Claims 8, 21-25, and 28-30 have been amended.

Amendments

Claim 8 has been amended to correct a typographical error. Claims 21-24 have each been amended to claim method steps that are consistent with the description found in the Specification on page 7, lines 4-21. Claim 25 has been amended to require program instructions that are consistent with the description found in the Specification on page 7, lines 4-21. Claims 28-30 have been amended to require program instructions that are consistent with the description found in the Specification on page 5, line 13 through page 6, line 14 and page 7, lines 4-21. Consequently, the amendments do not add new matter.

Claim Objection

The Examiner objected to Claims 27 and 30 noting some typographical errors. Claim 27 has been cancelled and Claim 30 has been amended to address the Examiner's concerns.

Rejection under 35 U.S.C. § 101

The Examiner rejected Claims 28-30 as being directed to non-statutory subject matter. Claims 28-30 have been amended to address the Examiner's concern.

Rejections Under 35 U.S.C. § 102

The Examiner rejected Claims 1-4, 8-10, 14-17, and 21-30 under Section 102(e) citing the publication "Web 390 for OS/390 and MVS," Information Builders (hereinafter IB). A claim is anticipated if, and only if, each and every limitation set forth in the claim can be found expressly or inherently in a single piece of prior art.

CLAIMS 1-4: This first group of claims are directed to a method for providing an application access to one or more third party legacy data list to a user of an application program. Claim 1 is independent. Claims 2-4 depend from Claim 1. Claim 1 requires the following limitations:

1. querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list;

2. receiving, from said one or more plug-in modules found in said registry, identifications of ones of said one or more third party legacy data list corresponding to said found one or more plug-in modules; and

3. providing a list of said identifications to said user through a user interface of said application program.

Rejecting Claim 1, the Examiner cited IB, page 1, paragraphs 1, 5, and 6. IB describes a web server (IB web server) designed to offer access to mainframe based productions systems (referred to as CICS, IMS/DC, TSO, and VM/CMS or "3270" applications) from any web browser. IB, page 1, paragraph 1. The IB web server "popular Web file formats." IB, page 1, paragraph 5. It supports CGI scripts, JavaScripts, and 3GL languages for accessing native MVS data. IB, page 1, paragraph 5. The IB web server is designed to provide a 3270 emulation mode in which a web browser plug-in can deliver "familiar 3270 green screens." IB, page 1, paragraph 6. The IB web server is also designed to provide an "HTML translation mode, which automatically converts 3270 datastreams into HTML forms." IB, page 1, paragraph 6.

Nothing in the cited sections teaches querying an operating system registry for a plug-in capable of interfacing with a third party legacy data list as required by the first limitation. IB describes a web browser (Netscape) plug-in that is capable if interfacing with the IB web server. That web server plug-in is not capable of interfacing with a third party legacy data list as required by the first limitation above. Moreover nothing in the cited sections teaches or suggests receiving from a plug-in an identification of one or more third party legacy data lists let alone providing the such a list though a user interface of an application program as required by the second and third limitations above.

For these reasons, Claim 1 is felt to distinguish over IB. Claims 2-4 each depend from Claim 1 and include all of the limitations of that base claim. As such, Claims 2-4 are felt to distinguish over IB.

CLAIMS 8-10: This second group of claims are directed to a system version of the method(s) of claims 1-4. Claim 8 is independent. Claims 9 and 10 depend from Claim 8. Claim 8 requires the following limitations:

1. one or more plug-in modules, each of which being:
   a. capable of interfacing with an associated one of said one or more third party data list,
   b. registered in a registry of an operating system of said computer system; and
2. an application program having a user interface, said application program:
   a. upon starting being in communication with said operating system to query said registry to determine registered ones of said one or more plug-in module,
   b. configured to query each of said registered ones of said one or more plug-in modules for names of said one or more third party legacy data list,
   c. configured to provide a list of said names of said one or more third party legacy data list to said user through said user interface.

The Examiner asserts that, for the same reasons Claim 1 is anticipated by IB, so is Claim 8. It is presumed then that the Examiner bases the rejection of Claim 8 on IB, page 1, paragraphs 1, 5, and 6. As pointed out above, nothing in these cited sections teaches a plug-in capable of interfacing with a third party legacy data list as required by the first limitation of Claim 8. Moreover, nothing in the cited sections teaches an application program capable of querying plug-in modules to identify third party legacy data lists let alone providing such a list through a user interface.

For these reasons, Claim 8 is felt to distinguish over IB. Claims 9 and 10 each depend from Claim 8 and include all of the limitations of that base claim. As such, Claims 9 and 10 are felt to distinguish over IB.

CLAIMS 14-17: This third group of claims are directed to computer readable medium with instructions for performing the method(s) of claims 1-4. Claim 14 is independent. Claims 15-17 depend from Claim 8. Claim 14 requires a computer readable medium with instructions for performing the following limitations:

1. querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list;

2. receiving, from said one or more plug-in modules found in said registry, identifications of ones of said one or more third party legacy data list corresponding to said found one or more plug-in modules; and

3. providing a list of said identifications to said user through a user interface of said application program.

The Examiner asserts that, for the same reasons Claim 1 is anticipated by IB, so is Claim 14. It is presumed then that the Examiner bases the rejection of Claim 14 on IB, page 1, paragraphs 1, 5, and 6. As pointed out above, nothing in these cited sections teaches a plug-in capable of interfacing with a third party legacy data list as required by the first limitation of Claim 8. Moreover, nothing in the cited sections teaches receiving from plug-in modules identifications of third party legacy data lists let alone providing such a list through a user interface.

For these reasons, Claim 14 is felt to distinguish over IB. Claims 15-17 each depend from Claim 14 and include all of the limitations of that base claim. As such, Claims 15-17 are felt to distinguish over IB.

CLAIMS 21-24: This fourth group of claims are directed to a method for providing an application access to a third party legacy data list not supported by the application program. Claim 21 is independent. Claims 22-24 depend from Claim 1. Claim 21, as amended, requires the following limitations:

1. supplying a plug-in module capable of providing an interface between the application program and the third party legacy data list;
2. the application program sending a request function call to the plug-in;
3. the plug-in module, in response to the request function call, returning an identification of the third party legacy data list;
4. the application program sending an availability function call to the plug-in module; and
5. the plug-in module, in response to the availability function call, indicating whether or not the third party legacy data list is available

IB does not teach supplying a plug-in capable of interfacing with a third party legacy data list as required by the first limitation. IB describes a web browser (Netscape) plug-in that is capable if interfacing with the IB web server. That web server plug-in is not capable of interfacing with a third party legacy data list as required by the first limitation above. Moreover IB does not teach or suggests making identification and availability function call let alone responding the such function calls as required by the remaining limitations of Claim 21.

For these reasons, Claim 21 is felt to distinguish over IB. Claims 22-24 each depend from Claim 21 and include all of the limitations of that base claim. As such, Claims 22-24 are felt to distinguish over IB.

CLAIM 25: This fifth group is directed to a computer readable medium having a program or programs for carrying out a number of the method steps of Claim 2. For the reasons Claim 21 distinguishes over IB so does Claims 25.

CLAIMS 28-30: This sixth group of claims are directed to a computer readable media storing a plug-in module for providing an application program with access to a third party legacy data list not supported by the application program. The plug-in module is required to include:

1. an application program interface operable to

- receive a request function call from the application program and respond with an identification of the third party legacy data list;
- receive an availability function call from the application program and respond with an indication of whether or not the third party legacy data list is available; and
- receive a data function call from the application program; and

2. a data list interface data operable, in response to the data function call, to interface with and access the third party legacy data.

IB does not describe a plug-in having the capabilities required by Claim 28. IB describes a web browser (Netscape) plug-in that is capable if interfacing with the IB web server. That web server plug-in is not capable of interfacing with a third party legacy data list as required by Claim 28. Moreover IB does not teach or suggests a program that is capable of making or responding to request, availability, or data function calls as required by Claim 28.

For these reasons, Claim 28 is felt to distinguish over IB. Claims 29-30 each depend from Claim 28 and include all of the limitations of that base claim. As such, Claims 29-30 are felt to distinguish over IB.

Rejections Under 35 U.S.C. § 103

The Examiner rejected Claims 5-7, 11-13, and 18-20 under Section 103(a). To establish a prima facie case of obviousness under Section 103, the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; that there is a reasonable expectation of success; and that the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP § 2142 (citing In re Vaeck, 947 F.2d 488, (Fed. Cir. 1991)).

CLAIMS 5, 11, AND 18: The Examiner rejected these claims as being unpatentable over IB in view of Tsukamoto (USPN 5,857,073). Claim 5 depends from Claim 4 which depends from Claim 1. Claim 11, depends ultimately from Claim 8, and Claim 18 depends ultimately from Claim 15. For the same reasons Claims 1, 8 and 15 distinguish over IB, so do Claims 5, 11, and 18.

Nonetheless, Claim 5, requires the following additional limitations not taught by IB or Tsukamoto:

1. the application program comprises a facsimile software; and
2. one or more third party legacy data list comprise one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software.

Claim 11 is a system version of the method of Claim 5. Claim 18 is directed to a computer medium having instructions for performing the method of Claim 5.

Rejecting Claims 5, 11, and 18, the Examiner admits that IB does not teach the above limitations. Instead, with reference to the first limitation above, the Examiner cites Tsukamoto, col. 4, lines 10-18, col. 5, lines 16-65, col. 11, lines 14-16, and Fig. 5. The cited sections discuss a network made up of client terminals, a facsimile server, a file server, and a number of facsimile devices. Tsukamoto, col. 5, lines 16-26. A facsimile device includes a mailbox group stored in its own RAM, and the mail box group contains a number of mail boxes. Tsukamoto, col. 5, lines 17-35. Each mail box contains a mail box number, a user name, an identification ID, and addresses of received facsimile messages. Tsukamoto, col. 5, lines 36-40.

Upon receipt of a facsimile message for a particular user, a facsimile device writes an address in the reception message area of the user's mail box and stores the facsimile message in its memory at that address. Tsukamoto, col. 5, lines 41-46. 16-26 The facsimile server can then supply a user name and an identification, and the facsimile device will transfer the facsimile message to the facsimile server. Tsukamoto, col. 5, lines 46-49.

Fig. 5 illustrates a flow of changed registration data specific to a facsimile device. Tsukamoto, col. lines 54-55. Fig. 5 illustrates "setting data" stored in the RAM of a facsimile device and consisting of a name, a telephone number, and an auto reception indicator. Tsukamoto, col. 9, lines 63-65. Also illustrated is a general data group stored on the facsimile server. The setting data has been

changed and differs from the general data. The general data is updated (presumably by some nondescript software operating on the facsimile server) to reflect changes made to the setting data. Tsukamoto, col. 10, lines 52-56.

While it is not clear, it is assumed that the Examiner is equating nondescript software running on a facsimile server with the facsimile software of Claim 5. It is also assumed that the Examiner is equating the general data with the list of names and telephone numbers making up a legacy data list of Claim 5. Claim 5 has been amended to clearly indicate that the legacy facsimile software (used to store the names and telephone numbers of a legacy data list) is different from the facsimile software that is the application program. The nondescript software running on Tsukamoto's facsimile server is more akin to the legacy facsimile software of Claim 5.

Neither IB or Tsukamoto, alone or in combination, teach an application program that is a facsimile software and a legacy data list that is a list of names and telephone numbers stored by a legacy facsimile software that is different than the facsimile software that is the application program. For this reason, Claims 5, 11, and 18 are felt to distinguish over the cited art.

CLAIMS 6, 12, AND 19: The Examiner rejected these claims as being unpatentable over IB in view of Sampath (USPN 6,266,744). Claim 6 depends from Claim 4 which depends from Claim 1. Claim 12, depends ultimately from Claim 8, and Claim 19 depends ultimately from Claim 15. For the same reasons Claims 1, 8 and 15 distinguish over IB, so do Claims 6, 12, and 19.

Nonetheless, Claim 6, requires the following additional limitations not taught by IB or Sampath

1. the application program comprises an e-mail software; and
2. one or more third party legacy data list comprises one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software.

Claim 12 is a system version of the method of Claim 6. Claim 19 is directed to a computer medium having instructions for performing the method of Claim 6.

Rejecting Claim 6, the Examiner admits that IB does not teach the above limitations. Instead, with reference to the first limitation above, the Examiner cites

Sampath, col. 4, lines 33-43. The cited section discusses a server computer that is programmed to generate invoices that can be sent, for example, via electronic mail. The cited section describes invoicing software not e-mail software as required by Claim 6.

With reference to the second limitation, the Examiner cites Sampath, col. 6, lines 15-18. This section describes a billing database (connected to the server computer) that can contain an e-mail address. While not clear, it is presumed that the invoicing software on the server computer is responsible for storing the e-mail address in the billing database.

Neither IB or Sampath, alone or in combination, teach an application program that is an e-mail software and a legacy data list that is a list of e-mail addresses stored by a legacy facsimile software that is different than the facsimile software that is the application program. For this reason, Claims 6, 12, and 19 are felt to distinguish over the cited art.

CLAIMS 7, 13, AND 20: The Examiner rejected these claims as being unpatentable over IB in view of Gottsman (USPN 6,134, 548). Claim 7 depends from Claim 4 which depends from Claim 1. Claim 13, depends ultimately from Claim 8, and Claim 20 depends ultimately from Claim 15. For the same reasons Claims 1, 8 and 15 distinguish over IB, so do Claims 7, 13, and 20.

Nonetheless, Claim 7, requires the following additional limitations not taught by IB or Gottsman:

1. the application program comprises a personal organizer software; and
2. one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise compatible with the application program using a legacy personal organizer software.

Claim 13 is a system version of the method of Claim 7. Claim 20 is directed to a computer medium having instructions for performing the method of Claim 7.

Rejecting Claim 7, the Examiner admits that IB does not teach the above limitations. Instead, with reference to the first limitation above, the Examiner cites Gottsman, col. 37, lines 9-12. The cited section reads as follows:

A Personal Digital Assistant (PDA) with Internet access can synchronize the person's calendar, email, contact list, task list and notes on the PDA with the version stored in the Internet site. This enables the person to only have to maintain one version of this data in order to have it available whenever it is needed and in whatever formats it is needed.
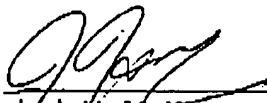
Neither IB or Gottsman, alone or in combination, teach an application program that is a personal organizer software and a legacy data list that is contact information and appointment information stored using a legacy personal organizer software that is different than the facsimile software that is the application program. For this reason, Claims 7, 13, and 20 are felt to distinguish over the cited art.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1-25 and 28-30 are all in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,
David Bohan

By _____
Jack H. McKinney
Reg. No. 45,685

July 9, 2004